

In re Appln. of: Mary Swaab  
Application No.: 09/714,318

31. The method of claim 7 further comprising selecting various bases from a plurality of bases to provide a desired texture and consistency for the lip coloring product, mixing the selected bases with the measured quantities of selected pigments.

B8 32. The method of claim 7 further comprising premixing the measured quantities of pigments to arrive at a desired shade and color for the lip coloring product, said premixing being conducted prior to said mixing.

33. The method of claim 32 further comprising adding the premixed measured quantities of pigments to said at least one base prior to said heating.

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#### REMARKS

The Office Action dated August 27, 2002, has been carefully considered. Claims 1-20 and 22-29 were rejected while claim 21 was indicated to include allowable subject matter. By way of this amendment, claims 1, 7, 8, 11, 14, 19, 23, 25, and 26 have been amended. Claims 30-33 have been added. Claims 1-33 remain in this application. Applicant respectfully requests re-examination and reconsideration of the rejections in view of the foregoing amendments and the following remarks.

Turning first to the claim objections and § 112 rejection raised in paragraphs 1-3 of the Office Action, claim amendments have been put forth to claim 26 in that the step of adding has been changed to mixing with the word "mixed" being deleted before "lipstick pigments". In view of this amendment, it is believed that the § 112 rejections of claims 26-29 are now moot. With respect to the objections raised with respect to claim 8, Applicant has carefully studied claim 8 and it is not seeing what the Patent Examiner is pointing out. Specifically, based on Applicant's review of claim 8, it appears that the phrase "at least one lipstick base" already appears after the word softened. Therefore, Applicant respectfully requests that the claim objections of claims 8 and 9 be withdrawn. (If Applicant is misunderstanding what the Patent Examiner is referencing, Applicant invites a telephone call.) It should also be noted for the record that a number of claim amendments delete text or limitations which make the claims

broaden in one respect. As will be noted below, further amendments have been put forth to certain claims to better define the claimed invention over the prior art of record.

Turning first to the obviousness rejections, claims 1-6, 19, 22-25, and 29 have been rejected as being obvious over Collins et al. in view of Lombardi et al. The basis for this rejection is not understood because Lombardi et al. when combined with Collins et al. does not arrive at the presently claimed invention. Therefore, the prior art references when combined do not "teach or suggest all claim limitations" which is one of the basic requirements for a prima facie case of obviousness under MPEP § 2143. In particular, the cited Lombardi et al. reference appears to teach a virtual or hypothetical computerized color match based on various inputs as shown for example in FIG. 9 and does not disclose any opportunity for adjusting the base pigment mixture after it has actually been applied to the lips of a person for evaluation. Indeed, this is explicitly illustrated in diagrammatic form in FIG. 1 of Lombardi et al. in which the final color is selected as the very first step and based on that selected final color the weight and color combination of pellets is selected. Further, the process for selecting a final color is only done in the digital virtual world using a computer as disclosed in the last two paragraphs of column 5 and first paragraph of column 6. Thus, when Lombardi et al. and Collins et al. are combined, the result still is that a final color is selected and finally settled upon prior to any activity relating to making a lipstick product. In fact, Lombardi et al. discloses that the final color must be selected in order to determine a formula (e.g. determining the weight and color combination of pellets) according to the second step as indicated in FIG. 1 of Lombardi et al.

In contrast, as shown in claim 1, there is clearly the opportunity for further adjustment of the base pigment mixture after it has been mixed. Claim 1 sets up a very specific order of steps with the words "thereafter" at strategic locations in the claim. Importantly, additional heating and cooling is performed after the "applying" step according to the express order set up in claim 1. A similar limitation does not exist anywhere in the two cited references. Additionally, the further step of adding at least one pigment during the step after the applying step and before the heating step to adjust the base pigment mixture as claimed in claim 2 is also not disclosed in either Lombardi et al. or Collins et al.

Because the Patent Examiner has failed to identify specific claim limitations as claimed in claim 1, it is submitted that the asserted references when combined fail to teach or suggest all of the claim limitations and therefore removal of the obviousness rejections is respectfully

solicited under MPEP § 2143. For similar reasons relating to the "repeating" step of claim 19, the obvious rejection should be withdrawn for claim 19 and its dependent claims.

Turning to the anticipation rejections under 35 U.S.C. § 102, claims 7-18 and 26-28 were rejected as anticipated by Collins et al., U.S. Patent No. 5,780,018. Under MPEP § 2131, an anticipation rejection is only appropriate if a cited reference teaches every element and limitation of the claim. In response to the anticipation rejection, independent claims 7, 14, 19, and 26 have been amended to more clearly define the present invention over the cited Collins et al. reference.

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The Patent Examiner correctly notes in paragraph 5 of the Office Action that Collins et al. teaches using different color pellets which contain pigment to arrive at a particular shade for the lipstick. In contrast, the present invention does not use color pellets, but instead uses pigments which are in powder or liquid form, which are not in a standard unit of measurement (see Applicant's disclosure, pg. 8, lns. 7-8 regarding powder pigments; and FIG. 1 generally, and pg. 6, lns. 20-25 concerning pouring of liquid pigments which are contained in pigment containers noted at Ref. No. 24). Unlike pellets which are predetermined units of measurement with a definite shape according to the teachings of Collins et al., powders and pigments have no given shape and are therefore amorphous. Thus, claims 7, 14, 19, and 26 have been amended to recite that the method utilizes a plurality of pigments "in shapeless amorphous form". This alone is sufficient to rebut the anticipation rejection that has been advanced.

Furthermore, the use of pigments in shapeless amorphous form gives further meaning to the measuring step set forth in claims 7, 14, 19, and 26. For example, claim 7 as amended now specifies "measuring quantities of selected pigments with a measuring device while the pigments are in shapeless amorphous form" (similar recitations appear in claims 14, 19, and 26). In contrast, Collins et al. does not teach measuring quantities of selected pigments, nor use of a "measuring device" to measure quantities of such selected pigments. Instead, as expressly disclosed in Collins et al.:

"The operator has only to count out the different color pellets to be added according to a predetermined formula and then add the required number of doses of the oil blend as dictated by the same formula." Col. 3, ln. 67, Col. 4, ln. 2.

Thus, there is no measuring of selected pigments with a measuring device taught by Collins et al.

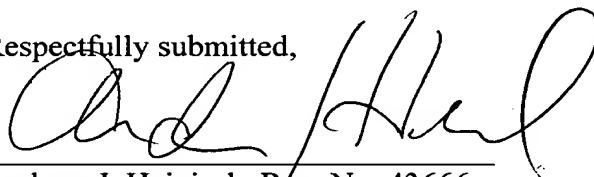
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In view of the substantial differences in the claim language as now presented in the amended claims, and the disclosure of Collins et al., it is submitted that the present invention is not anticipated by Collins et al. Therefore, the Applicant respectfully requests the Patent Examiner to withdraw the prior art rejections and to issue a Notice of Allowance in this patent application.

CONCLUSION

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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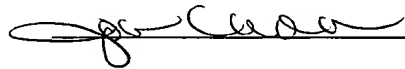
Date: November 22, 2002

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CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class mail in an envelope addressed to: Commissioner for Patents, BOX FEE AMENDMENT, Washington, D.C. 20231.

Date: November 22, 2002

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PATENT  
Attorney Docket No. 500991

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:  
Mary Swaab

Art Unit: 1732

Application No.: 09/714,318

Examiner: Stefan Staicovici

Filed: November 16, 2000

For: METHOD FOR BLENDING AND  
FABRICATING PERSONALIZED  
LIPSTICK

**AMENDMENTS TO CLAIMS  
MADE IN RESPONSE TO OFFICE ACTION DATED AUGUST 27, 2002**

Amendments to existing claims:

1. (First Amended) A method for custom blending and fabricating a lipstick at a retail establishment to personal specifications of a person, the method comprising:  
receiving a customer demand from the person for a custom blended lipstick at the retail establishment;  
mixing selected quantities of a plurality of selected pigments in accordance with the customer demand to arrive at a pigment mixture;  
softening at least one lipstick base via heat such that the lipstick base is suitable for mixing with pigments; thereafter  
mixing the pigment mixture with the ~~softened~~ at least one lipstick base to arrive at a base-pigment mixture; thereafter  
applying the base-pigment mixture to lips of the person for evaluation; thereafter  
heating the base-pigment mixture; and  
cooling the base-pigment mixture in a mold.

7. (First Amended) A method for custom blending and fabricating lip coloring product to personal specifications of a person of using a kit at a retail establishment,

the kit including a mold, a plurality of pigments in shapeless amorphous form and a plurality of at least one bases, the method comprising the steps of:

receiving a customer demand from the person for a custom blended lipstick lip coloring product at the retail establishment;

heating the at least one base;

selecting various pigments from the plurality of differently shaded pigments in shapeless amorphous form based upon the customer demand;

measuring quantities of selected pigments with a measuring device while the pigments are in the shapeless amorphous form;

mixing selected measured quantities of bases and the pigments for lip coloring product with the at least one base selected from a plurality of pigments and bases; and

heating the bases and pigments into liquefied form;

cooling the mixed at least one bases and pigments in a mold.

8. (First Amended) The method of claim 7 wherein the mixing step comprises:

mixing selected quantities of a plurality of selected measured pigments in accordance with the customer demand to arrive at a pigment mixture;

softening at least one lipstick base via heat such that the lipstick base is suitable for mixing with measured pigments; and thereafter

mixing the pigment mixture with the softened at least one lipstick base to arrive at a base-pigment mixture.

11. (First Amended) The method of claim 7 wherein the heating step is performed in a microwave oven the measuring step is performed with at least one measuring device selected from the group consisting of a graduated blending sheet, a scoop, a spoon, a dropper, a measuring cup, and a metering device.

14. (First Amended) A method for custom blending and fabricating lip coloring product using a kit at home, the kit including a mold, a plurality of pigments in shapeless amorphous form and at least one base, the method comprising the steps of:

selecting various pigments from the plurality of differently shaded pigments in shapeless amorphous form;

measuring quantities of selected pigments with a measuring device while the pigments are in shapeless amorphous form;

~~mixing selected-measured quantities of the at least one base and pigments for lip coloring product selected from a plurality of pigments and bases with the at least one base to form a mixture of a desired shade and texture, the mixing step being conducted at the home;~~

~~heating the bases and pigments into liquefied form, the heating step being conducted at the home; and~~

~~cooling the bases and pigments in a mold, the cooling step being conducted at the home.~~

19. (First Amended) A method for custom blending and fabricating lip coloring product to personal specifications, the method comprising the steps of:

selecting various pigments from a plurality of differently shaded pigments in shapeless amorphous form;

measuring quantities of the selected pigments with a measuring device while the selected pigments are in shapeless amorphous form;

mixing the measured quantities of selected pigments;

repeating the selecting, measuring and mixing steps until a desired shade of lipstick is achieved;

~~selecting a base from a plurality of lipstick bases offering a variety of textures and consistencies;~~

~~adding the mixed lipstick pigments to the selected base;~~

~~heating the pigments and at least one base in a heating vessel to a liquid-mixable form;~~

adding the measured quantities of lipstick pigments to the at least one base; and  
pouring the liquefied and mixed pigments and at least one base into a mold.



23. (First Amended) The method of claim 19 wherein ~~the heating step is performed using a microwave oven~~ said mixing of the measured quantities of pigments is conducted prior to said adding of the measured quantities of pigments to the at least one base.

25. (First Amended) The method of claim 19 further including the step of adding additional pigment after ~~the said heating step and said adding~~ to further tailor the lipstick to the exact specifications of the user.

26. (First Amended) A method for custom blending and fabricating lipstick at a retail establishment to personal specifications, the method comprising:

receiving a demand from an individual person for a custom blended lipstick at the retail establishment;

selecting various pigments from a plurality of differently shaded pigments in shapeless amorphous form;

measuring quantities of the selected pigments with a measuring device and while the selected pigments are in shapeless amorphous form in accordance with the demand of the individual person;

selecting at least one base from a plurality of lipstick bases offering a variety of textures and consistencies in accordance with the demand of the individual person;

adding-mixing the measured quantities of mixed-lipstick pigments to-with the at least one selected base;

heating the pigments and at least base into mixable form ~~into a liquid form~~; and pouring the ~~liquefied and mixed~~ pigments and at least one base into a mold.